

REMARKS

I have considered the Office Action of 20 July 2001, and wish to express my appreciation to the Examiner for the detailed review and discussion of the underlying application. At the same time, it is submitted that the rejections based both on recapture and substantively based on prior art are in error, and should be removed, thus placing this reissue application in condition for allowance.

On the issue of alleged "recapture" and the rejection of the new claims (20-27) based on 35 U.S.C. 251, the rejection is based on the erroneous assertion that certain subject matter was "surrendered" during prosecution of the underlying application. According to the Office Action, the related features of "diverging sides of the closure" and "the diverging guide means" have been removed or modified from the new reissue claims, and were allegedly "at the point of novelty" of patent claim 1. Even assuming, *arguendo*, that the latter assertion was true, both assertions do not combine to establish "surrender" of the subject matter being claimed in the new reissue claims. As review of claim 1 as originally filed makes clear, the "diverging" features cited by the Examiner were present in claim 1 as originally filed:

1. A roll-up closure device typically for use on vehicle shelters of the type defining at a front end thereof a door opening having lateral sides which diverge from top to bottom, comprising a pair of guide means adapted to be mounted to the vehicle shelter substantially at the lateral sides of the door opening and substantially parallel thereto thereby diverging from top to bottom an overhead roller means adapted to be rotatably mounted inside the vehicle shelter and substantially horizontally adjacent an upper end of the door opening, a

flexible closure means adapted to be secured at a top end thereof to said roller means, at least a section of said flexible closure means having a shape which tapers in direction of said roller means and including diverging lateral side edges adapted to be engaged in said guide means, whereby a rotation of said roller means causes said flexible closure means to displace along said guide means and to wind around said roller means or to unwind therefrom for displacing said flexible closure means towards an open or a closed portion thereof, respectively, wherein in said closed position, said section of said flexible closure means substantially completely closes the door opening. (emphasis added).

During prosecution, these originally-present features were admittedly relied upon by the applicants in distinguishing original claim 1 (and thus the later-added dependent claims) over the cited prior art. At most, this set of facts establishes only that applicants initially chose a novel aspect of their design (namely the diverging features), and that they then established the novelty and non-obviousness of that aspect of their design. This set of facts does not establish that a claim scope without the "diverging" features was surrendered during that prosecution.

For example, this is not a situation where the "diverging" features were added to the claims in an attempt to distinguish over cited art. Nor is this a situation where the applicants stated or even intimated that the claimed subject matter was not patentable but for the "diverging" features. Again, the "diverging" features were present in claim 1 from the beginning. Indeed, it is this inclusion of the "diverging" features in original claim 1 and the

subsequent continued reliance on that feature to establish patentability that are the "errors" being asserted and relied upon in presenting this reissue application (see Statement of Error accompanying reissue filing). The Examiner's position would seem to suggest that the broader (in certain respects) coverage that applicants are now seeking was "surrendered" simply by virtue of not being presented in the claims of the original application. A requirement such as this, that an applicant properly identify ALL coverage to which he is entitled at the time of the filing of a patent application, would vitiate the reissue process which specifically recognizes the possibility of error occurring that would result in unduly narrow coverage.

The Office Action's assertion that the "diverging" features cannot be eliminated from the claims because they are at the "point of novelty" of the issued claims improperly presupposes that claims without this feature are not patentable. This Office Action's assertion focuses on the claims that were presented (which all included the "diverging" feature) and ignores the fact that claims of a broader (in certain respects) scope which did not include the "diverging" feature were erroneously omitted from the application. Of course the distinguishing feature of the issued claims as compared to the cited art was "necessary for patentability." But that does not mean that only claims including that feature are patentable, and the point of this reissue is to indeed establish that other features can distinguish over the prior art of record. Presenting claims that eliminate the "diverging" limitations, but that add other distinguishing features do not represent an attempt to "recapture" claims without the "diverging" limitations, but rather represent an attempt to supplement applicant's coverage by focusing on a different feature of the applicant's disclosure that also defines over the art of record.

Before turning to a discussion of that art of record, it is noted that paragraph 2 of the Office Action rejected the claims as indefinite as it was allegedly unclear whether or not the door opening was being claimed. Amendment has been made to claims 20 and 26 in an attempt to clarify that the door opening is indeed not being claimed.

Turning to the rejections of the new (20-27) claims on the art, the first such rejection rejects claims 20-22 as anticipated by the Kelley Tuffflex beam publication. This rejection is traversed as being improper, since there are elements present in the rejected claim which are not asserted in the rejection to be present in the prior art device. Specifically, while the rejection says that “the Tuffflex beam is stated as being resilient,” it does not state that the reference includes other structure present in claim 20, notably “guide engagement members couplable to the curtain for movement therewith and engageable with the guide members to restrict their movement toward the curtain center.” Moreover, while the rejection states that the reference identifies the beam as resilient, the rejection does not state that this “resilient” beam is “a discrete elastic member coupled to the curtain for movement therewith and extending laterally across the curtain, and disposed such that the elastic member can be stretched between the restricted side engagement members,” as recited in claim 20. If the Examiner is of the belief that such structure is indeed found in the reference, a proper 102 rejection would specifically point out the structure in the reference that corresponds to the claimed structure, and such detail is respectfully requested. Without such detail, it is impossible to argue the propriety of the rejection, and the applicants are apprehensive to engage in conjecture in light of the draconian result of any amendment or argument for reasons of patentability eliminating coverage under the Doctrine of Equivalents under the Festo decision. As it stands the anticipation rejection here is improper and should be withdrawn.

In a similar vein, the anticipation rejection of claim 26 as rejected by Coenraets is improper and should be withdrawn. In making the rejection, the Office Action fails to point to structure in the reference that corresponds to structure in the rejected claim. Specifically, the Office Action does not identify structure in the reference that corresponds to a “laterally inwardly-biasing means for maintaining the curtain taut.” While the Office Action states that such structure is disclosed in the Coenraets reference, the cited passage from that patent establishes no such thing. The cited passage only states that the compression spring exerts “a certain traction on the guide track 3, in a direction perpendicular to the longitudinal axis of said guide track.” There is nothing in the cited passage (and thus nothing in the rejection) that establishes that the force exerted on the tracks is exerted on the closure as well. Nothing in Coenraets would prevent such a force from being exerted on the tracks, but nonetheless leave the curtain untensioned, despite the Action’s suggestion to the contrary. Accordingly, it is submitted that a proper 102 rejection has not been made out based on Coenraets, and that such rejection should be withdrawn.

Turning to the obviousness rejection of claims 20-22 based on Kraeutler '902, it is submitted that such rejection is improper and should be withdrawn. While the Office Action has stated that the polyester material is inherently resilient, it has ignored the remaining teaching of the reference regarding that polyester material that prevents that reference from rendering the present invention obvious. In Kraeutler, the strap 102 is discussed in the following way: “each strap is disposed inside a sheath constituted by two plastic sheets 103a and 103b that are slightly wider than the strap, and that are welded together along their edges, the resulting assembly being welded or glued to the flexible curtain 101.” Given the presence of the “inherently resilient, at least to a minimum extent” strap sandwiched between and sealed within two rigid plastic sheets, it is submitted that the quoted language teaches

away from the claimed structure of an elastic member that "can be stretched between the restricted guide engagement members." The Office Action has not identified a teaching, suggestion, nor indeed even a motivation to one of ordinary skill in the art to modify the structure disclosed in the reference to arrive at the claimed invention. This omission renders the rejection improper, and suggests it should be withdrawn.

As to the remaining rejections, they are directed to dependent claims 23 and 24, which themselves depend from independent claim 20, the patentability of which has been established by the above showing that the rejections of that independent claim were improper.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned **“Version With Markings To Show Changes Made.”**

Respectfully submitted,

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Version With Markings to Show Changes Made

In the claims:

Please amend claims 20 and 26 as follows:

20. (Amended) A roll-up closure device adapted to be disposed adjacent a door opening and movable between blocking and unblocking position relative thereto, and comprising:

 a roller adapted to be rotatably mountable adjacent an upper end of the door opening;

 a curtain adapted to be secured at a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively;

 guide members adapted to be disposed at the lateral sides of the door opening; guide engagement members couplable to the curtain for movement therewith and engageable with the guide members to restrict their movement toward the curtain center; and

 a discrete elastic member coupled to the curtain for movement therewith and extending laterally across the curtain, and disposed such that the elastic member can be stretched between the restricted guide engagement members.

26. (Amended) A roll-up closure device adapted to be disposed adjacent a door opening and movable between blocking and unblocking position relative thereto, and comprising:

 a roller adapted to be rotatably mountable adjacent an upper end of the door opening;

a curtain adapted to be secured at a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively;

guide members adapted to be disposed at the lateral sides of the door opening; and

laterally inwardly biasing means for maintaining the curtain taut, and for allowing the curtain to yield depth-wise for an applied force.